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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,305	10/20/2003	Anthony J. Baerlocher	112300-1797	6910

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Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, IL 60690-1135

EXAMINER	
ASHBURN, STEVEN L	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,305	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *7-12* is/are allowed.

6)☒ Claim(s) *1-6,13-18 and 21-23* is/are rejected.

7)☒ Claim(s) *19 and 20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

Claims 1, 2, 4, 13-16, 18 and 21-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,669,559 in view of Manz, US 5,494,287 (Feb. 27, 1996).

Claims 1, 2, 4, 13-16, 18, 21-23. The '559 patent describes all the claimed features except randomly selecting match values from the set of match values upon a pair of related symbols being displayed. Manz identifies the need to develop new and exciting game machines to avoid the repetitive nature of typical gaming devices. *See col. 1:58-2:7.* To solve this problem, the reference provides a gaming device in which the payout for a game outcome is randomly selected from a set of payout amounts. *See col. 2:11-20.* The selection is made only after the game outcome occurs. *See id.* In Manz, the game outcomes are comprised of sets of related symbols (e.g. A-A-A). *See fig. 7, 8.* Thus, it was within the ordinary skill of an artisan at the time of the invention to randomly select values from a set of values upon a pair of related symbols being displayed.

In view of Manz, it would have been obvious to an artisan at the time of the invention to modify the gaming device claimed in the '559 patent to add the feature of randomly selecting a match value from a set of match values upon the display of a pair of related symbols. As suggested by Manz, the modification would enhance the excitement of the gaming device by creating a feeling of suspense surrounding the value of the outcome. *See col. 2:5-8, 6:49-51.*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 13-18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. US 6,190,255 (Feb. 20, 2001) in view of Manz.

Claims 1 and 13. Thomas discloses a gaming device comprising: (a) a plurality of selections; a plurality of symbols, wherein each of said symbols is associated with one of the selections and at least one pair of the symbols is related; (c) at least one set of match values associated with the symbols, wherein at least two match values in said set are different; (d) at least one display device adapted to display the selections, (e) a processor operable with the display device to enable the player to pick at least one of the selections, cause the symbol associated the player picked selection to be displayed by the display device, and upon the pair of related symbols being displayed by the display device randomly select at least one of the match values from the set of match values and award said randomly selected match value to the player and (f) repeating the above steps at least once. *See fig. 8, 9; col. 9:50-11:60.* However, Thomas does not disclose randomly selecting match values from a set of match values upon a pair of related symbols being displayed. Regardless, as discussed below, this feature would have been obvious to one of ordinary skill in the art at the time of the invention.

Manz identifies the need to develop new and exciting game machines to avoid the repetitive nature of typical gaming devices. *See col. 1:58-2:7.* To solve this problem, the reference provides a gaming device in which the payout for a game outcome is randomly selected from a set of payout amounts. *See col. 2:11-20.* The selection is made only after the game outcome occurs. *See id.* In Manz, the game outcomes are comprised of sets of related symbols (e.g. A-A-A). *See fig. 7, 8.* Thus, it was within the ordinary skill of an artisan at the time of the invention to randomly select values from a set of values upon a pair of related symbols being displayed.

In view of Manz, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Thomas, wherein a match value is awarded for game outcomes comprised of pairs of matching selections, to add the feature of randomly selecting the match value from a set of match values upon the display of a pair of related symbols. As suggested by Manz, the modification would enhance the excitement of the gaming device by creating a feeling of suspense surrounding the value of the outcome. *See col. 2:5-8, 6:49-51.*

Claim 2. Thomas discloses including a plurality of pairs of related symbols. *See col. 11:51-60.*

Claims 3 and 17, In addition to all the features discussed with respect to claim 1, Thomas additionally describes at least one termination scheme associated with an additional symbol which includes at least one additional pick of one of the selections wherein the termination scheme associated with the unrelated symbol is initiated when the unrelated symbol is displayed. *See col. 11:61-12:19.* Thomas provide an "end-bonus outcome" which terminates the game when the symbol is displayed. *See id.* If the player possess a "bonus resource", the player may make at least one additional pick. These features constitute a termination scheme associated with an additional symbol which includes at least one additional pick of one of the selections wherein the termination scheme associated with the unrelated symbol is initiated when the unrelated symbol is displayed.

Claims 4 and 18. Thomas discloses at least one basic value associated with each of the symbols, wherein said basic value is awarded to the player when the symbol associated with the basic value is displayed by the display device. *See col. 11:14-42.*

Claim 5. Thomas a plurality of unrelated symbols, each unrelated symbol associated with at least one termination scheme. *See fig. 9, col. 11:61-12:19.*

Claim 6. Thomas discloses including a plurality of pairs of related symbols. *See col. 11:51-60.*

Claims 14, 15, 21 and 22. The gaming device suggested by the combination of Thomas and Manz does not describe operating the gaming device through a data network, including the Internet. Regardless, it was notoriously well known in the art at the time of the invention to operate gaming devices through a data network, including the Internet, in order to allow remotely located players to participate in the games and thereby increase the potential market for the service. Thus, the examiner takes official notice that it would have been obvious to an artisan at the time of the invention to modify gaming device suggested by the combination of Thomas and Manz to add the feature of operating the gaming device through a data network, including the Internet to increase the potential market for the service by providing access to remotely located players and thereby increase the operator revenues.

Claims 16 and 23. Thomas discloses storing computer instructions for implementing the game process in a memory device. *See fig. 12, 14; col. 16:37-54.*

Allowable Subject Matter

Claims 7-12, 19 and 20 are allowed.

Claims 19 and 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of the examiner's reasons for allowance:

Claims 7-9 and 20. The prior art does not teach or suggest a termination scheme associated with an unrelated symbol including a predetermined number of picks of selections, wherein the termination scheme is initiated when the unrelated symbol associated with the player picked selection is displayed.. The prior art describes termination schemes associated with symbols wherein a player may continue to play even though he has selected a terminating symbol. *See, e.g., Thomas, US 6,190,255, col. 11:61-12:19.* The prior art additionally describes symbols that allow the player a limited number of additional picks. *See, e.g., Bennett, WO 98/09259, fig. 1(56).* However, the prior art does not teach or suggest a game terminating scheme in which a symbol causes a game to end after allowing players a limited number of additional picks. Thus, claim 7 is allowable. Claims 8 and 9 are allowable as being dependent upon claim 7. Claim 20 is objected to as being dependent upon rejected claim 17.

Claims 10-12 and 19. The prior art does not teach or suggest a termination scheme associated with an unrelated symbol that causes the bonus round to terminate upon a next pair of related symbols being displayed, wherein the termination scheme is initiated when the unrelated symbol associated with the player picked selection is displayed. The prior art describes termination schemes associated with symbols wherein a player may continue to play even though he has selected a terminating symbol. *See, e.g., Thomas, US 6,190,255, col. 11:61-12:19.* The prior art additionally describes termination schemes in which a bonus round is terminated upon a pair of related symbols being displayed. *See, e.g., Schneider et al., US 6,089,976, col. 3:31-35.* However, the prior art does not teach or suggest a game terminating scheme in which a symbol cause the game to end after allowing players to receive an additional pair of related symbols. Thus, claim 10 is allowable. Claims 11 and 12 are allowable as being dependent upon claim 10. Claim 19 is objected to as being dependent upon rejected claim 17.

Prior Art, Not Relied On

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

a. WO 98/09259 discloses a selection-type gaming device in which some selections award the player additional selections.

b. US 6,024,642 discloses a gaming device in which a predetermined losing combination may result in the player receiving an award.

c. US 6,270,409 discloses a gaming device in which a player may continue to play until receiving a winning combination of symbols.

d. US 6,089,976 discloses a gaming device in which a player selects symbols until receiving a matching pair.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

MARK SAGER
PRIMARY EXAMINER